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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,825	05/22/2001	Satoru Ueda	7217/64562	8871

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EXAMINER

YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
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2192

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/862,825

Applicant(s)

UEDA, SATORU

Examiner

Michael J. Yigdall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action is responsive to Applicant's submission filed on September 29, 2005. Claims 1, 3, 4 and 10 are now pending.

Response to Arguments

2. Applicant's arguments with respect to the limitations added to claims 1 and 10 have been fully considered but they are not persuasive.

Applicant submits that, "although Grundy appears to teach a free use of an evaluation version of a software program and a paid use of a full-function software program, Grundy fails to show or suggest providing a display in user terminal having a graphical-user-interface for enabling a user to select between free access to a software program and paid access to a software program including a selected one of a plurality of supplemental pay functions" (Applicant's remarks, pages 6-7, bridging paragraph).

However, Grundy does in fact disclose a graphical user interface on which the software program displays a banner page to enable the user to select between free use of the evaluation version and paid use of the full-function version (see, for example, column 12, lines 6-24), as presented in the claim rejections below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Pub. No. WO 97/14085 to Reeder (art of record, "Reeder") in view of U.S. Patent No. 5,375,240 to Grundy (art of record, "Grundy") in view of U.S. Patent No. 6,081,785 to Oshima et al. (art of record, "Oshima").

With respect to claim 1 (currently amended), Reeder discloses a software program providing system for providing and managing access to a software program (see, for example, FIG. 1 and page 3, lines 11-15), comprising:

(a) a storage medium for storing said software program and an individual identification code for identifying said storage medium (see, for example, store 150 in FIG. 1, and page 5, lines 1-7, which shows a store or storage medium for storing a software program and an identification code used to identify the program in the storage medium);

(b) a user terminal for installing said storage medium therein and for accessing said software program stored in said storage medium (see, for example, apparatus 100 in FIG. 1, and page 3, lines 11-15 and line 32 to page 4, line 6, which shows a personal computer or user terminal having a storage medium installed therein for storing and accessing software programs; also see, for example, page 5, lines 10-14, which shows obtaining the software program and storing it in the storage medium);

(c) database management means for storing a database including individual information of a user, information regarding a range of access limitations to said software program, and information regarding a condition of access to said software program, wherein said database is searched using said individual identification code as a search key (see, for example, code data

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230 and bill log 240 in FIG. 1, and page 6, line 37 to page 7, line 5, which shows a data store or database having individual user information regarding software usage rights, i.e. access limitations and conditions of access, which is searched based on an identification code), wherein said information regarding said range of access limitations includes a plurality of supplemental pay functions and said information regarding said condition of access includes purchased counts and used counts (see, for example, page 10, lines 17-27, which shows a plurality of supplemental pay features or functions; also see, for example, page 11, lines 8-19, which shows a condition of access for the feature or function based on a message number, and page 10, lines 31-34, which shows that the message number is incremented when a feature or function is purchased and thus represents a purchased count; also see, for example, page 11, line 31 to page 12, line 14, which shows recording each use of the feature or function, i.e. as a used count), and

said database management means further comprises fee charging means for charging a fee for adding purchased counts only to access a selected one of said plurality of supplemental pay functions (see, for example, page 9, lines 25-27, which shows fee charging means for charging a fee to access the supplemental pay functions; also see, for example, page 13, lines 7-15, which shows that access to the functions may be prepaid).

Although Reeder discloses charging a fee for supplemental pay functions (see, for example, page 9, lines 25-27), Reeder does not expressly disclose the limitation wherein said software program is accessed for free unless access to one of said plurality of pay functions is requested.

However, Grundy discloses a system for distributing and managing access to a software program that is accessed for free unless access to certain functions is requested, so that the user

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may freely evaluate and legally distribute copies of the software program without paying a fee (see, for example, column 4, lines 28-42 and 51-59).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder such that the software program is accessed for free unless access to one of said plurality of pay functions is requested, as taught by Grundy, so as to allow the user to evaluate and legally distribute the software program without paying a fee.

Reeder also discloses:

(d) information communication means for connecting said database management means with said user terminal (see, for example, communications link 10 and network 20 in FIG. 1, and page 3, lines 21-31), wherein

said software program providing system authorizes said user terminal to access said software program stored in said storage medium based on said information regarding said range of access limitations (see, for example, page 7, lines 30-37), said information regarding said condition of access to said software program, and said information searched using said individual identification code as said search key (see, for example, page 6, line 37 to page 7, line 5), said database management means reading said individual identification code from said storage medium installed in said user terminal through said information communication means (see, for example, page 10, lines 6-17, which shows reading a identification code from a storage medium, and page 11, lines 15-29, which then shows authorizing the use of a software program based on access limitations and conditions).

Grundy further discloses the limitation wherein:

said user terminal includes a display having a graphical-unit-interface for enabling a user to select between free access to said software program and paid access to said software program including said selected one of said plurality of supplemental pay functions (see, for example, column 12, lines 6-24, which shows a graphical user interface on which the software program displays a banner page to enable the user to select between free access to the software program in evaluation mode and paid access to the software program in full-function mode).

Reeder does not expressly disclose limitation wherein said storage medium is a removable storage medium.

However, Oshima discloses a system for providing and managing access to a software program stored with an identification code on a removable, optical storage medium, wherein the software is installed on a user terminal from the removable storage medium, for the purpose of preventing illegal copying of the software (see, for example, column 10, lines 15-54; also see, for example, FIG. 11, which shows a personal computer or user terminal and an optical disk drive).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to provide the software program on a removable storage medium to be installed in the user terminal, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to enhance the level of protection against illegal copying or installation of the software.

With respect to claim 3 (previously presented), Reeder also discloses the limitation wherein said information communication means further comprises ciphering means for ciphering communication between said database and said user terminal (see, for example, page 7, lines 5-9, which shows an encryption or ciphering process).

With respect to claim 4 (original), although Reeder discloses the use of encryption to provide additional security (see, for example, page 5, line 33 to page 6, line 1), Reeder does not expressly disclose the limitation wherein said storage means further comprises a DVD-ROM and said individual identification code includes a BCA code recorded through a laser beam during a fabrication process of said individual identification code.

However, Oshima further discloses the use of the BCA to store an identification code and a cryptographic key (see, for example, column 1, lines 36-50) on a DVD (see, for example, column 3, lines 63-67), so that a fee may be charged for the use of the disk (see, for example, column 4, lines 60-64). Oshima further discloses that the BCA code is recorded with a laser during fabrication and can be used for security (see, for example, column 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Reeder to use a DVD-ROM storage medium with a BCA identification code, as taught by Oshima. The modification would have been obvious because one of ordinary skill in the art would have been motivated to improve security by transcribing the storage medium with an individual identification code.

With respect to claim 10 (currently amended), the claim recites a software program providing system that corresponds to the software program providing system of claim 1 (see the rejection of claim 1 above).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdall
Examiner
Art Unit 2192

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SUPERVISORY PATENT EXAMINER